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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/726,085 | 12/02/2003 | Donald E. Weder | 8403.825 | 3420 |

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EXAMINER

SELLMAN, CACHET I

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/726,085 | Applicant(s) WEDER, DONALD E. | |
| | Examiner Cachet I. Sellman | Art Unit 1762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 26-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/17/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-25, drawn to methods for producing decorative grass, classified in class 427, subclass 289.
- II. Claims 26-51, drawn to a decorative grass, classified in class 428, subclass 15.

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of Group II can be made by a materially different process such as by performing the plurality of segments prior to application of the decorative pattern formed of glitter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kathryn Hester on January 30, 2006, a provisional election was made without traverse to prosecute the invention of a method for producing decorative grass, claims 1-25. Affirmation of this election must be made by applicant in replying to this Office Action. Claims 26-51 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-10, and 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weder (US 6258447 B1) in view of Kukoff (US 2001/0047847).

In regards to claim 1, Weder discloses a method for forming decorative grass with a complete (abstract) pattern which consists of providing a sheet or web of material having an upper and a lower surface (column 1, lines 48-50) and cutting the sheet or web of material into a plurality of segments to produce decorative grass (column 1, lines 53-55) so that each piece has a specific complete pattern (column 3, lines 18-19).

In regards to claim 9, Weder discloses providing a sheet of flexible, laminated material having an upper and lower surface comprising a first sheet having a upper and lower surface; a second sheet having an upper and lower surface is laminated to the lower surface of the first sheet material and cutting the sheet into a plurality of segments (column 4 lines 38-47 and column 5, lines 14-20)

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Weder does not teach that the surface of the material has a decorative pattern formed of glitter as required by **claims 1 and 9**.

Kukoff discloses a method for forming a light-reflective decorative glittered article, which consists of depositing glitter flakes onto an adhesive in a predetermined pattern [0017]. This method can be used on fabrics as well as paper in order to give the article a rich, full and uniform appearance.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the process of Weder to include forming a decorative pattern on the sheet using glitter as taught by Kukoff. One would have been motivated to do so because both disclose processes for applying a decorative pattern to a paper product, Weder teaches that the sheet of material may have various coatings, metallic finishes or decorative surface ornamentation that can be applied separately (column 5 lines 60-63) and Kukoff further teaches that the glitter gives the article a richer, fuller and uniform appearance.

Weder discloses that the sheet or web material should have a thickness of about 0.1 – 10 mil (column 4, lines 18-20) as required by **claim 2**. Kukoff discloses that the glitter can be applied by either mixing the glitter with an adhesive then applying it to the article in a pattern or applying the adhesive to the substrate in a pattern then sprinkling the glitter over the adhesive [Figs 1 and 3] as required by **claims 3- 6**. The sheet or web

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material may be paper, cellophane, foil, plastic film, metallized film, fabric, burlap or combinations thereof (column 4, lines 61-64) as required by **claim 8**.

Weder discloses forming a pattern on the upper surface of the first material and the lower surface of the second material so that the pattern is disposed on the upper and lower surfaces of the sheet of flexible, laminated material (column 5, lines 60-67 – column 6, lines 1-3) as required by **claim 10**. As stated above the glitter can be applied by mixing the glitter with the adhesive then applying it to the article as required by **claims 12 and 13** or a coating can be applied to the article in a pattern then the glitter is applied to the coating as required by **claims 14 and 15**. Weder discloses that the decorative patten is formed on the surface of the first sheet material prior to lamination so that it is visible through on of the surfaces of the laminated material (column 5, line 52-56) as required by **claim 16**. The first and second sheet of material can be substantially transparent or translucent so the decorative patten is visible through the upper surface of the laminated material (column 6, lines 5-7) as required by **claims 17 and 18**. As stated above the glitter can be applied by mixing the glitter with the adhesive then applying it to the article as required by **claims 19 and 20** or a coating can be applied to the article in a pattern then the glitter is applied to the coating as required by **claims 21 and 22**. Weder discloses that the thickness of the first and second sheet of material is preferably 0.4 - .9 mil (column 4, lines 18-19) as required by **claim 23**. The first and second sheet of material can be paper, cellophane, foil, plastic film, metallized

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film, fabric, burlap or combinations thereof (column 4, lines 61-64) as required by **claims 24 and 25.**

3. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weder in view of Kukoff as applied to claims 1, 9, and 10 in further view of Neavin et al (US 2001/ 0013668 A1).

The teachings of Weder in view of Kukoff as applied to claims 1, 9, and 10 are as stated above.

Weder in view of Kukoff does not teach applying a coating to the glitter in order to prevent the decorative pattern from being distorted, disrupted or destroyed as required by **claims 7 and 11.**

Neavin et al. discloses applying glitter to paper, fabrics, cardboard, films, ornaments, plastics, wood, and metal to provide a decorative effect. Neavin et al. discloses that the glitter can be placed on a substrate in a variety of patterns by using glue, or adhesives. Neavin et al. further discloses that a coating (i.e. clear coating) can be applied over the glitter to provide additional bonding, protection or a more visually appealing effect 00197- 198].

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the process of Weder in view of Kukoff to include the step of providing a coating to the glitter pattern as taught by Neavin et al. One would have been motivated to do so because both disclose depositing glitter to paper or fabric substrates using an adhesive to provide a decorative effect and Neavin et al. further discloses that the use of a coating will provide additional bonding, protection and a more visually appealing effect.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cachet I. Sellman whose telephone number is 571-272-0691. The examiner can normally be reached on Monday through Friday, 7:00 - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cachet Sellman
Patent Examiner
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TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to be 'T. Meeks', with a large loop at the top and a vertical line extending downwards.